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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/528,762	03/17/2000	Paramasiviah Harshavardhana	20-1-1-1-8-1	5011

7590 08/18/2004

Ryan, Mason & Lewis, LLP  
1300 Post Road  
Suite 205  
Farifield, CT 06824

EXAMINER

HYUN, SOON D

ART UNIT PAPER NUMBER

2663

DATE MAILED: 08/18/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 13

Application Number: 09/528,762  
Filing Date: March 17, 2000  
Appellant(s): HARSHAVARDHANA ET AL.

\_\_\_\_\_  
Kevin M. Mason  
For Appellant

**MAILED**

AUG 18 2004

**Technology Center 2600**

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed June 15, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-11, 13-32, and 34-44 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

Art Unit: 2663

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 8-11, 16-21, and 43 are rejected under 35 U.S.C. 102(e). This rejection is set forth in a prior Office Action, mailed on 02/19/2004.

Claims 6, 7, 13-15, 22-32, 34-42, and 44 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, mailed on 02/19/2004.

**(11) Response to Argument**

In the paragraph bridging pages 3-4 of Appeal Brief, referring to lines 6-13 on page 14 of the specification, Appellant argues that Chaudhuri does not disclose "signaling path transits non-conforming network elements" because nodes 12F and 12G of Chaudhuri participate in the signaling and restoration of service and have the necessary functionality and data bases; therefore, the 12F and 12G are conforming network elements. Examiner disagrees for the following reasons.

First, it is the claims, not the specification, that define the invention, it should be noted that no structural or functional difference between the claimed "non-conforming network elements" and nodes 12F and 12G could be found from the language of claim 1.


Second, although the claims are interpreted in light of specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In the instant application, claim 1 does not exclude the necessary functionality and data bases; thus, it is irrelevant whether nodes 12F and 12G have the necessary functionality and data bases. Third, the specification does not set forth the definition of "non-conforming network elements" with reasonable clarity,

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deliberateness and precision; and exemplification is not an explicit definition. In light of the specification, "non-conforming network elements" may be, for example, network elements provided by a number of manufactures (page 14, lines 6-9). This is exactly what Chaudhuri discloses at col. 3, lines 17-22.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Soon D. Hyun



Conferees: Chau T. Nguyen  
SPE AU 2663



Hassan Kizou  
SPE AU 2662

Ryan, Mason & Lewis, LLP  
1300 Post Road  
Suite 205  
Farifield, CT 06824